Paper No. 26

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Ex parte DIETER MULLER

Appeal No. 2004-2337
Application No. 09/214,047

ON BRIEF

Before SCHEINER, MILLS, and PAWLIKOWSKI, **Administrative Patent Judges**.

PAWLIKOWSKI, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. § 134 from the examiner's final rejection of claims 1, 3, 4, and 5. Claims 1, 4, and 5 are exemplary of the subject matter on appeal, and are set forth below:

1. Pharmaceutical administration form in the form of a magnetic tape as an electromagnetic memory comprising the bioresonance spectrum of a medical compound being suited to have a direct effect on a biological receptor system, said spectrum being generated in the frequency range of 1 Hz to 150Hz, amplified and recorded on said magnetic tape.

4. Method for the manufacture of a pharmaceutical administration form of a medical compound which is suited to have direct effect on a biological receptor system, comprising the steps of putting the medical compound in an resonator vessel, generating a bioresonance signal of the medical compound continuously generated by means of a frequency generator having a frequency range of 1 Hz to 150 kHz, amplifying the bioresonance signal by a predetermined factor, and storing the amplified bioresonance signal on an electromagnetic memory.

5. Therapeutical method for the treatment of a diseased state of a patient, comprising the steps of applying a magnetic tape as an electromagnetic memory to the skin of a patient, said tape comprising a bioresonance spectrum of a medical compound in a predetermined amplification, said spectrum being generated on the frequency range of 1 Hz to 150 Hz, amplified and recorded on said magnetic tape whereby the medical compound is applied for elimination of diseased state.

On page 3 of the brief, appellant states that claims 1 and 3 through 5 should be separately considered with respect to the issues under 35 U.S.C. § 102 and § 112. To the extent that any one claim is argued with specific arguments regarding its patentability, we consider such claim in this appeal. See 37 CFR § 1.192(c)(7)(2003); and 37 CFR § 41.37(c)(1)(vii)(effective September 13, 2004; 69 Fed. Reg. 49960 (August 12, 2004); 1286 Off. Gaz. Pat. Office 21 (September 7, 2004)). Our consideration of a particular claim is indicated under each of the respective headings below, corresponding to a particular rejection.

Claims 1 and 3 through 5 stand rejected under 35 U.S.C.

§ 112, second paragraph (indefiniteness).

Claims 1 and 3 through 5 stand rejected under 35 U.S.C. § 112, first paragraph (enablement).

Claim 1 stands rejected under 35 U.S.C. § 102(b) as being anticipated by Brenner.

Claims 1, 3, and 5 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Whitson-Fischman.

Claims 1 and 3 through 5 stand rejected under 35 U.S.C. § 102(e) as being anticipated by Dillinger.

The examiner relies upon the following references as evidence of unpatentability:

Dillinger et al. (Dillinger)	5,830,140	Nov. 03, 1998
Whitson-Fishman	5,162,037	Nov. 10, 1992
Brenner (German Patent Publication)[1]	DE 3419055A1	Nov. 28, 1985

Schöni, "Efficacy Trial of Bioressonance in Children with Atopic Dermatitis" International Arch Allergy Immunol. Vol. 12, (March 1997), pp. 238-246

We have carefully reviewed appellant's brief, the examiner's answer and supplemental examiner's answer, and the evidence of record. This review as has led us to the following determinations.

[1] Pursuant to a supplemental examiner's answer, in response to a remand mailed September 22, 2003, the examiner provided an English translation of the German reference to Brenner.

OPINION

I. The rejection of claims 1 and 3 through 5 under 35 U.S.C. § 112, second paragraph (indefiniteness)

We consider claims 1, 3, 4, and 5 in this rejection.

We refer to pages 3-4 of the answer regarding the examiner's position for this rejection. The examiner discusses several phrases in the claims before us that he finds are indefinite. Our focus concerns the terms "predetermined factor", "predetermined amplification", and "[p]harmaceutical administration form in the form of a magnetic tape as an electromagnetic memory".

Appellant's response to this rejection is set forth on pages 4-5 of the Brief. Appellant states that the meaning of a term such as "predetermined factor" pertains to the dosage of the medication, and the dosage depends on the medication to be used, and on the disease, on the patient, and other circumstances, and that therefore no specific range need be given for such terms. Appellant states that "the amplification should be determined appropriately in every specific case, as with conventional medicine, but without undue experimentation[2]." Id. Appellant states that, therefore, it is believed that these expressions are self explanatory, and well understood, by persons of ordinary skill in the art. Brief, pages 4-5.

In response, the examiner states that "when interpreting a claim term which is ambiguous, such as a pre-selected level of force, [one] must look to the specification for the meaning

[2]Appellant's use of the term "undue experimentation" is not appropriate with regard to the issue of indefiniteness under 35 U.S.C. § 112, second paragraph. That is, it is the first paragraph of 35 U.S.C. § 112, with regard to enablement, that requires that the specification teach those having ordinary skill in the art to make and use the invention without "undue experimentation." In re Vaeck, 947 F.2d 488, 495-96, 20 USPQ2d 1483, 1444-45 (Fed. Cir. 1991).

ascribed to that term by the inventor." The examiner states that "if the specification had defined such a term, the limitation would have been deemed definite." The examiner states that in the instant case, the terms "predetermined factor" and "predetermined amplification" are ambiguous. The examiner also states that "[i]n fact, Appellant agrees that it depends on various factors, none of which is well enumerated in the specification". The examiner concludes that in the absence of "a clear definition within the specification, the terms are deemed indefinite". Answer, pages 12-13.

Furthermore, we point out that appellant's explanation of the terms in the Brief is mere attorney argument. It is the specification which must set forth the metes and bounds of the claims.

We also note that the requirement under 35 U.S.C. § 112, second paragraph, is that the claims set out and circumscribe a particular area with a reasonable degree of precision and particularity. In re Moore, 439 F.2d 1232, 1235, 169 USPQ 236, 238 (CCPA 1971). Also, the purpose of the second paragraph of Section 112 is to basically insure, with a reasonable degree of particularity, an adequate notification of the metes and bounds of what is being claimed. See In re Hammack, 427 F.2d 1378, 1382, 166 USPQ 204, 208 (CCPA 1970). Also, set forth in Amgen Inc. v. Chugai Pharmaceutical Co., Ltd., 927 F.2d 1200, 1217, 18 USPQ 1016, 1030 (Fed. Cir. 1991):

> The statute requires that "[t]he specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention." A decision as to whether a claim is invalid under this provision requires a determination whether those skilled in the art would understand what is

> claimed. See Shatterproof Glass Corp. v. Libbey-Owens Ford Co., 758 F.2d 613, 624, 225 USPQ 634, 641 (Fed. Cir. 1985) (Claims must "reasonably apprise those skilled in the art" as to their scope and be "as precise as the subject matter permits.").

Furthermore, claim language must be analyzed "not in a vacuum, but always in light of the teachings of the prior art and of the particular application disclosure as it would be interpreted by one possessing the ordinary skill in the pertinent art." In re Moore, 439 F.2d 1232, 12354, 169 USPQ 236, 238 (CCPA 1971).

Upon our review of the specification, we find that the specification discloses that the "bioresonance frequency spectrum of the medical compound is copied within a range of about 1 Hz to 150 kHz, and the vibration spectrum is amplitude-amplified". See page 5, last paragraph of appellant's specification. The specification also states that the vibration spectrum of the medical compound is then transferred, via an output conduit, to a second cup electrode, into which the magnetic memory, for example, in the form of a piece of a magnetic tape, has been inserted. Specification, page 5 last three lines.

From the above-mentioned disclosure, it appears that after the bioresonance frequency spectrum is copied, the vibration spectrum is then amplitude-amplified, followed by the creation of the electro magnetic memory for formation of the magnetic tape, using the amplitude-amplified vibration spectrum. The specification, however, does not explain any relationship between the alleged medication, dosage, disease, or patient status, which allows one of ordinary skill in the art to

predetermine or select a particular, appropriate degree of amplification. Nor do the amplification values provided in the examples in the specification shed any light on how one of ordinary skill in the art would have arrived at the values provided therein, or understand the metes and bound of "predetermined" amplification.

Hence, terms such as "predetermined amplification" (in claim 5) or "predetermined factor" (in claim 4), or the word "amplified" (in claim 1), are interelated to the claimed phrase "[p]harmaceutical administration form in the form of a magnetic tape as an electro-magnetic memory" (found at lines 1-2 of claim 1), because, the amplitude amplified vibration spectrum is used in creating the magnetic tape for making the electromagnetic memory, which is the pharmaceutical administration form. While we appreciate appellant's comments that a selected value[3] of amplification depends upon the kind of compound, the type of disease, and the type of patient, etc., the specification does not explain how the claims set out and circumscribe, for example, what type of medical compound has what kind of direct effect on what kind of biological receptor system, and how such effect actually occurs and why it occurs, according to appellant's invention. Because the kind of direct effect on what kind of biological receptor system is uncertain, the degree of amplification is likewise not circumscribed with a reasonable

[3] We note that on page 27 of the specification, example 1 states that frequencies are amplified by a predetermined factor, and the value of 200 is given. Likewise, Example 2 uses a value of amplification of 34, before the signal is transferred to the videotape. See page 30, Example 2, of appellant's specification.

degree of precision and particularity. As such, the meaning of "pharmaceutical administration form in the form of a magnetic tape as an electromagnetic memory" cannot be ascertained either, because this term is intricately related to the amplification of the vibration spectrum, as discussed, supra. Hence, the claims do not particularly point out and distinctly claim the invention as required by 35 U.S.C. § 112.

Further, given that no details, of what type of medical compound has what kind of direct effect on what kind of biological receptor system (and how), and to what degree (which may depend upon the value of amplification), are set forth in the specification, the claims, as presently written, do not circumscribe the boundaries of the claims with a reasonable degree of particularity. In re Moore, 439 F.2d 1232, 1235, 169 USPQ 236, 238 (CCPA 1971).

In view of the above, we affirm the rejection of claims 1 and 3 through 5 under 35 U.S.C. § 112, second paragraph (indefiniteness).

II. The Rejection under 35 U.S.C. § 112, first paragraph (enablement)

Because we have affirmed the rejection of claims 1 and 3 through 5 under 35 U.S.C. § 112, second paragraph (indefiniteness), we reverse this rejection pro forma. That is, because we are unable to determine the metes and bounds of these claims, we cannot address the issue as to whether these claims are enabled under 35 U.S.C. § 112, first paragraph. See In re Moore, 439 F.2d 1232, 1235, 169 USPQ 236, 238 (CCPA 1971).

III. The Art Rejections

Analysis of whether a claim is patentable over the prior art under 35 U.S.C. § 102 or § 103 begins with a determination of the scope of the claim. The properly interpreted claim must then be compared with the prior art.

Because the appealed claims fail to satisfy the definiteness requirements of the second paragraph of § 112, it reasonably follows that the examiner's rejections under § 102 cannot be reached at this time.

To that end, the predecessor of our appellant reviewing court has held that it is erroneous to analyze claims based on "speculation as to the meaning of the terms employed and assumptions" as to their scope. In re Steele, 305 F.2d 859, 862, 134 USPQ 292, 295 (CCPA).

Consequently, in comparing the claimed subject matter with the applied art, it is apparent that considerable speculations and assumptions are necessary in order to determine what in fact is being claimed. Since a rejection based on prior art cannot be based on speculations and assumptions, we reverse, pro forma, the examiner's § 102 rejections. Id.

IV. Conclusion

The 35 U.S.C. § 112, second paragraph, rejection of claims 1, 3, 4, and 5 is affirmed. All of the other rejections are reversed, pro forma.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

AFFIRMED

TONI R. SCHEINER)
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